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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91164764
Party	Plaintiff Brink's Network, Incorporated
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Attachments	Motion for Leave to File Second Amended Notice of Opposition.pdf (14 pages) (510299 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BRINK'S NETWORK, INCORPORATED)	
)	
Opposer)	
)	
v.)	Opposition No. 91164764
)	
BRINKMANN CORPORATION)	
)	
Applicant)	

MOTION FOR LEAVE TO FILE SECOND
AMENDED NOTICE OF OPPOSITION

Opposer Brink's Network, Inc. respectfully moves the Trademark Trial and Appeal Board for leave to substitute the Second Amended Notice of Opposition submitted herewith for the Amended Notice of Opposition submitted with Opposer's Motion for Leave to File Amended Notice of Opposition filed on April 30, 2009.¹ The grounds for this motion are as follows:

- (1) The original Amended Notice of Opposition submitted with the Motion for Leave filed on April 30, 2009 asserted as an additional ground for opposition that Application Serial No. 76/483,115 contains a fraudulent representation in violation of TMEP § 903.03 as to the date of first use of the mark BRINKMANN in connection with the specific goods in International Class 9 which are the

¹ For purposes of clarity and to distinguish this paper, it is captioned Second Amended Notice of Opposition.

subject of the present opposition. The Second Amended Notice of Opposition submitted herewith contains the identical new ground for opposition, but no other new ground for opposition.

- (2) The original Amended Notice of Opposition submitted with the Motion for Leave filed on April 30, 2009, deleted Opposer's claim of ownership of Registration No. 2,476,114 because that registration was cancelled pursuant to § 8 of the Federal Trademark Act subsequent to the filing of the original Notice of Opposition.
- (3) The Second Amended Notice of Opposition submitted herewith also deletes Opposer's claim of ownership of Registration Nos. 2,691,470 and 2,646,784 because Affidavits of Use under § 8 of the Federal Trademark Act have not been filed in connection with those two registrations, and it is anticipated that they will be cancelled by the U.S. Patent and Trademark Office in due course.
- (4) Notwithstanding the cancellation of Registration Nos. 2,476,114 and the anticipated cancellation of Registration Nos. 2,691,470 and 2,646,784, Opposer reserves the right to rely on any common law rights in the marks covered by those registrations.
- (5) Applicant will not be prejudiced by granting Opposer leave to file the Second Amended Notice of Opposition because: (a) Applicant has not yet filed its response to Opposer's Motion for Leave to File an Amended Notice of Opposition or an Answer to the Amended Notice of Opposition; and (b) the elimination of Registration Nos.

2,476,114, 2,691,470 and 2,646,784 will *inter alia* simplify discovery and the defense of this proceeding.

For the reasons set forth above, Opposer requests that the Board grant Opposer leave to file the Second Amended Notice of Opposition submitted concurrently herewith. In order to facilitate the orderly progress of this proceeding, Opposer requests that the present motion and the Motion for Leave to File Amended Notice of Opposition filed on April 30, 2009, be decided concurrently.

BRINK'S NETWORK, INC.

Date: May 13, 2009

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CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the foregoing Motion for Leave to File Second Amended Notice of Opposition was served on the following attorneys of record for Applicant by Federal Express overnight courier service on this 13th day of May, 2009:

Gary A. Clark, Esq.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BRINK'S NETWORK, INCORPORATED)	
)	
Opposer)	
)	
v.)	Opposition No. 91164764
)	
THE BRINKMANN CORPORATION)	
)	
Applicant)	

SECOND AMENDED NOTICE OF OPPOSITION

Brink's Network, Incorporated, a Delaware corporation, located and doing business at 203 Bancroft Building, 3411 Silverside Road, Wilmington, Delaware 19810 (hereinafter "Opposer"), believes that it will be damaged by registration of the mark shown in Application Serial No. 76/483,115 with respect to certain of the goods described in said Application as alleged more fully below, and hereby opposes same.

The grounds for the opposition are as follows:

BACKGROUND

(1) Application Serial No. 76/483,115 (hereinafter the "opposed application"), as amended pursuant to the Order of the Board entered in this proceeding on June 28, 2005, seeks registration of the mark BRINKMANN for, *inter alia*, home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets in International Class 9 (hereinafter "home security systems and components").

(2) The opposed application was filed on January 17, 2003, based on a claim of Applicant's use of the mark BRINKMANN in interstate commerce in connection with home security systems and components on June 12, 1978.

(3) On information and belief, the June 12, 1978 date of first use stated in the opposed application with respect to the goods in International Class 9 is not applicable to the home security systems and components sold by Applicant under the mark BRINKMANN.

(4) Long prior to the January 17, 2003 filing date of the opposed application and the true date of Applicant's first use of the mark BRINKMANN in connection with home security systems and components, Opposer's predecessor adopted and used, and Opposer's related companies Brink's Home Security Inc. and Brink's, Incorporated are still using the trade name, trademark and service mark BRINK'S, alone and/or in combination with other words and design(s), in interstate commerce for commercial and residential security systems and equipment; residential and commercial security alarm and monitoring services; check and payroll processing and security services; and convention, exhibit and performance ticket sales and security services.

(5) Long prior to the January 17, 2003 filing date of the opposed application and the true date of Applicant's first use of the mark BRINKMANN in connection with home security systems and components, Opposer's predecessor adopted and used, and Opposer's related companies Brink's Home Security Inc. and Brink's, Incorporated are still using the trade name, trademark and service mark BRINK'S, alone and/or in combination with other words and design(s), in interstate commerce for commercial and residential security systems and equipment; residential and commercial security alarm and

monitoring services; check and payroll processing and security services; and convention, exhibit and performance ticket sales and security services.

(6) In accordance with § 5 of the Federal Trademark Act, all use of the trade name, trademark and service mark BRINK'S, alone and/or in combination with other words and design(s), by Opposer's related companies Brink's Home Security Inc. and Brinks, Incorporated inures to the benefit of Opposer.

(7) Opposer is the owner of the trade name, trademark and service mark BRINK'S. Opposer and its predecessor and related companies have continuously used the trade name and mark BRINK'S for commercial and residential security systems and related residential and commercial security alarm and monitoring services, among other goods and services, since long prior to the filing date of the opposed application and the true date of first use of the mark BRINKMANN by Applicant in connection with home security systems and components.

(8) Opposer's related company Brink's Home Security Inc. offers for sale and sells numerous residential and commercial security products and related services under the trade name, trademark and service mark BRINK'S, alone and/or in combination with other words and design(s).

(9) By virtue of the prior and continuous advertising and sales of commercial and residential security systems and related services under the mark BRINK'S, and the maintenance of premium quality standards relating thereto, purchasers of such goods and services and others have come to recognize the mark BRINK'S as a singular, highly distinctive indication of origin, as a consequence of which Opposer has established valuable goodwill and exclusive rights in this mark.

(10) The mark BRINK'S, alone and/or in combination with other words and design(s), had become exceedingly well-known and a famous mark within the meaning of § 43(c)(2)(A) of the Federal Trademark Act long prior to the filing date of the opposed application and the true date of Applicant's first use of the mark BRINKMANN in connection with home security systems and components.

(11) Opposer's related company Brink's, Incorporated duly registered the mark BRINK'S & Design for security transportation, namely, armored car transport services of currency, securities and other valuables; domestic and international air courier services; receiving and cashing checks for others, coin processing and wrapping and change services; payroll preparation and consolidation of deposits for others; cash maintenance of bank automatic teller stations; food stamp distribution services; selling tickets and handling proceeds from conventions, exhibits and performances for others in the United States Patent and Trademark Office under Registration No. 1,313,790 which issued January 8, 1985 and has been duly renewed. Opposer is the record owner of Registration No. 1,313,790 by virtue of an assignment recorded in the Assignment Branch on April 19, 1996 at Reel 1452, Frame 0600.

(12) Opposer's related company Brink's, Incorporated duly registered the mark BRINK'S (Stylized) for receiving checks; cashing the same; making up payrolls; carrying same or other moneys or securities; guarding and protecting same and paying payrolls; handling clearings; selling tickets; handling proceeds from conventions, exhibitions, and performances; repairing safes, chests, cash protectors and similar equipment in the United States Patent and Trademark Office under Registration No. 529,622 which issued August 22, 1950 and has been duly renewed. Opposer is the record owner of Registration No.

529,622 by virtue of an assignment recorded in the Assignment Branch on April 19, 1996 at Reel 1452, Frame 0600.

(13) Opposer's related company Brink's, Incorporated duly registered the mark BRINK'S for security transportation, namely, armored car transport services of currency, securities, and other valuables; domestic and international air courier services; air transport and air freight of goods in the United States Patent and Trademark Office under Registration No. 1,309,375 which issued December 11, 1984 and has been duly renewed. Opposer is the record owner of Registration No. 1,309,375 by virtue of an assignment recorded in the Assignment Branch on April 19, 1996 at Reel 1452, Frame 0600.

(14) Opposer's related company Brink's, Incorporated duly registered the mark BRINK'S HOME SECURITY for security alarm and monitoring system services in the United States Patent and Trademark Office under Registration No. 1,412,587 which issued October 7, 1986. Opposer is the record owner of Registration No. 1,412,587 by virtue of an Assignment recorded in the assignment Branch on April 19, 1996 at Reel 1452, Frame 0600.

(15) Opposer's related company Brink's, Incorporated duly registered the mark BRINK'S & Design for security alarm and monitoring system services in the United States Patent and Trademark Office under Registration No. 1,411,610 which issued on September 30, 1986. Opposer is the record owner of Registration No. 1,411,610 by virtue of an assignment recorded in the assignment Branch on April 19, 1996 at Reel, 1452, Frame 0600.

(16) Opposer duly registered the mark BRINK'S HOME SECURITY & Design for residential and commercial metal safes; keyed and combination metal locks; non-

metal residential and commercial safes under Registration No. 2,330,884 which issued March 21, 2000.

(17) Registration Nos. 1,313,790, 529,622, 1,309,375, 1,412,587, 1,411,610 and 2,330,884 are *prima facie* evidence of the validity thereof and Opposer's ownership and exclusive right to use the marks BRINK'S HOME SECURITY, BRINK'S HOME SECURITY & Design, BRINK'S, BRINK'S & Design, and BRINK'S (Stylized), respectively, in commerce and are constructive notice of Opposer's ownership thereof, all as provided by §§ 7(b) and 22 of the Federal Trademark Act of 1946, as amended. The right to use the marks BRINK'S HOME SECURITY, BRINK'S, BRINK'S & Design, and BRINK'S (Stylized) having become incontestable, Registration Nos. 1,313,790, 529,622, 1,309,375, 1,412,587, 1,411,610, 2,330,884 are conclusive evidence of Opposer's exclusive right to use the marks shown therein in commerce as provided by §§ 15 and 33(b) of the Federal Trademark Act.

**OPPOSITION BASED ON LIKELIHOOD
OF CONFUSION PURSUANT TO § 2(d)**

(18) The commercial and residential security systems and equipment, and related residential and commercial security alarm and monitoring services described in Opposer's Registration Nos. 1,313,790, 529,622, 1,309,375, 1,412,587, 1,411,610 and 2,330,884 and the home security systems and components therefor described in the opposed application are commercially related, and are likely sold and/or rendered to the same or overlapping classes of purchasers. Therefore, purchasers, prospective purchasers and others are likely to be confused, mistaken or deceived into the belief, contrary to fact, that Applicant's home security systems and components therefor sold under the mark BRINKMANN emanate from and/or are in some way sponsored or

approved by Opposer and/or that Applicant is somehow affiliated with Opposer, thereby damaging Opposer.

(19) Applicant is not lawfully entitled to the registration which it seeks for the reason, *inter alia*, that Applicant's mark BRINKMANN, as used in connection with the home security systems and components therefor described in the opposed application, so resembles Opposer's previously used and/or registered marks BRINK'S, BRINK'S & Design, BRINK'S (Stylized), BRINK'S HOME SECURITY, and BRINK'S HOME SECURITY & Design as to be likely to cause confusion, to cause mistake or to deceive within the meaning of § 2(d) of The Federal Trademark Act, thereby damaging Opposer.

OPPOSITION BASED ON LIKELIHOOD
OF DILUTION PURSUANT TO § 13(a)

(20) Applicant is not lawfully entitled to the registration which it seeks for the reason, *inter alia*, that its use of the mark BRINKMANN in connection with the home security systems and components described in the opposed application is likely to dilute the distinctiveness of Opposer's famous marks BRINK'S, BRINK'S & Design, BRINK'S (Stylized), BRINK'S HOME SECURITY, and BRINK'S HOME SECURITY & Design within the meaning of § 43(c) of the Federal Trademark Act, as amended.

OPPOSITION BASED ON MISUSE
OF REGISTRATION SYMBOL

(21) Attached hereto as Exhibit A is a true copy of a specimen submitted by Applicant in connection with the opposed application showing use of the mark BRINKMANN in connection with home security systems and components that displays the federal statutory registration symbol ® in association with the mark BRINKMANN.

(22) Applicant does not own a subsisting federal registration of the mark BRINKMANN that covers home security systems and components.

(23) Applicant's use of the federal statutory notice of registration symbol ® in association with the mark BRINKMANN as shown in Exhibit A constitutes a misuse of that symbol in violation of § 29 of The Federal Trademark Act and deceives the consuming public into believing that the mark is registered, thereby damaging Opposer.

OPPOSITION BASED ON FRAUDULENT
REPRESENTATION OF MATERIAL FACT

(24) The statement portion and the drawing page in the opposed application each state that June 12, 1978 is date of first use of the mark BRINKMANN in commerce in connection with all of the goods in International Class 9, including home security systems and components. No other date of first use is provided for any of the International Class 9 goods listed in the application.

(25) Applicant has admitted that it did not use the mark BRINKMANN for home security systems and components as of June 12, 1978.

(26) The statements in the opposed application that Applicant commenced use of the mark BRINKMANN in commerce in connection with all goods in International Class 9 on June 12, 1978 accordingly are false.

(27) Section 903.09 of the Trademark Manual of Examining Procedure ("TMEP § 903.09") provides that, in the context of an applicant's statement regarding the date of first use of a mark when the date of first use does not pertain to all items listed in a single class, the applicant should specify the goods within that multiple listing which actually correspond to the stated date of first use.

(28) In making the aforesaid knowing misstatement of material fact with respect to the date of first use of the mark BRINKMANN in connection with home security systems and components, Applicant failed to comply with TMEP § 903.09.

(29) Applicant's non-compliance with TMEP § 903.09 resulted in a material misrepresentation of fact because, if the present opposition had not been filed, it would have resulted in the issuance of a registration that contains an admittedly false statement as to the date of first use for home security systems and components.

(30) The opposed application was executed on November 22, 2002, by J. Baxter Brinkmann, President of Applicant, who declared subject to 18 U.S.C. § 1001 that all statements in the application are true.

(31) Mr. Brinkmann either knew or should have known that the mark BRINKMANN was not used in connection with Applicant's home security systems and components at least as early as June 12, 1978.

(32) The aforesaid knowing misstatement of a material fact, namely, the June 12, 1978 date of first use of the mark BRINKMANN in connection with home security systems and components asserted in the opposed application, constitutes a fraudulent misrepresentation that renders the opposed application void *ab initio*.

WHEREFORE, Opposer believes that the present opposition should be sustained and the registration of Applicant's mark refused.

BRINK'S NETWORK, INCORPORATED

Dated: May 13, 2009

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